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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/457,796 12/09/99 MATHUS

G 5044

EXAMINER

IM52/0926

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ART UNIT

PAPER NUMBER

1743

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4

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/457,796

Applicant(s)

MATHUS ET AL.

Examiner

P. K. Bex

Art Unit

1743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 April 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 16-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☒ Claim(s) 11-15 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 December 1999 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2,3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-15, drawn to a test tube rack having base and cover means, classified in class 422, subclass 104.
 - II. Claims 16-19, drawn to a test tube rack having a base, openings with support pads, cover, and latches, classified in class 220, subclass 780.
 - III. Claims 20-25, drawn to a test tube rack having a base, cover, latches and cover, classified in class 206, subclass 486.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions Group I and Group II; Group I and Group III are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the claimed test tube rack of Group I does not require the specific plurality of support pads positioned within the openings as claimed in Group II, or the specific base comprising base sidewalls including lengthwise tongues as recited in the claims of Group III, for patentability. The subcombination of Group II has separate utility such as an apparatus for supporting pipette tips. Additionally, the subcombination of Group III has separate utility such as an apparatus for storage container for surgical instruments.

Inventions II and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention of Group II has separate utility such as an apparatus for supporting pipette tip. See MPEP § 806.05(d).

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, and the search required for one group is not required for the others, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Patrick O'Shea on September 18, 2001 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-15. Affirmation of this election must be made by applicant in replying to this Office action. Claims 16-25 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Drawings

6. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: #24, see page 5, line 18; Axis A-A in Fig. 8, see page 8, line 6; and # 140, Fig. 12. Correction is required.

Specification

7. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: the limitation of the top surface being transparent as recited in claim 6 was not disclosed within the instant specification.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 1-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1, line 2, the recitation of "a base having an array of openings extending vertically therebetween", is confusing and indefinite. Between what? Moreover, how does the array of openings *extend vertically* from the base? Examiner has interpreted this to mean a plurality of openings are formed within the base.

Line 4, "said top surface" lacks antecedent basis.

Line 9, a limitation followed by linking terms (e.g., preferably, may be, for instance, especially) is considered indefinite since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired.

Line 9, "its" is vague and indefinite as to what element it refers to. Same deficiency was found in claims 2, 7, 10-11.

Claim 7, line 2, the term "closer" is a relative term which renders the claim indefinite. The term "closer" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. It is not clear as to what Applicant considers close to the bottom.

Lines 2-4, it is not clear as to whether "said bottom surface" and said "top surface" are referring to the base or the cover. Additionally, the base has not been positively recited as having bottom or top surfaces. Same deficiency was found in claim 8

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

11. Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Aiken (USP 6,138,863).

Aiken teach a multipurpose container having a cover and receptacle. The receptacle has a base, side and end walls. Additionally, the base comprises a plurality of slots or openings 110 therein. The container has a removable lid 120 with a notch 32 formed at the bottom surface of the lid. The notch including a surface which rotates around a trunnion 30, 36. The notch further comprising a ledge surface 40 (Figs. 4-8). Note: process limitations, i.e. the limitations describing the movement of the lid around the trunnion, have not been given any patentable

Art Unit: 1743

weight, since process limitations are not accorded patentable weight in a claim which is directed to an apparatus.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

14. Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Laska (USP 5,993,745) in view of Corsi et al (USP 4,942,271).

Laska teaches a storage assembly for holding multiple test tubes 56, 59 of varying heights and diameters. The assembly comprising a base and a transparent cover portion. The base comprising a plurality of openings 25, wherein a plurality of projecting support pads 30 A-D, 60 A-D are symmetrically positioned within the openings. Moreover, the pads comprise a surface 31 A-D, 61 A-D which engages the test tubes (Figs. 1A- 6A). However, Laska does not disclose the use of a rotatable and removable cover comprising a notch, wherein the notch includes a trunnion travel surface and a ledge surface, or a base comprising a trunnion. Corsi et al do teach

Art Unit: 1743

the use of a rotatable and removable cover. The cover comprising a notch, wherein the notch includes a trunnion travel surface 66, 166, 260 and a ledge surface 64, 162 and a base 14, 114, 214 comprising a corresponding trunnion 20, 120, 220. Additionally, Corsi et al do teach a latching means for securing the cover to the base (Figs. 1-13). Such a hinge system can be easily manufactured and does not require numerous parts.

Accordingly, it would have been obvious to one of ordinary skill in the art at the time of the claimed invention to have included in the test tube storage assembly of Laska the hinge system, as taught by Corsi et al, in order to provide a hinge system which can be easily manufactured and does not require numerous parts (column 1, lines 24-45).

Regarding the shape of the openings, it would have been an obvious matter of design choice to have made the shape of the openings in the base of Laska rectangular. Moreover, since applicant has not disclosed that rectangular openings solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with circular openings. This same reasoning applies to the shape of the surface pads.

15. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Laska (USP 5,993,745) and Corsi et al (USP 4,942,271) as applied to claim 1, and further in view of Berry, Jr. (USP 5,415,846).

Laska and Corsi et al as discussed above, do not teach the specific use of slide latches to secure the cover to the base. Berry, Jr. does teach two slide latch mechanisms 49 designed for securing the lid 22 to the tray 21. The base comprising first and second base sidewalls 25, 26 each having a slide surface having a lengthwise groove 31 which mates with a lengthwise tongue 58 of the slide latch (Figs. 1-3, 6-7). Note: lengthwise has been interpreted to mean along the

57

direction of length of the respective elements, wherein these elements not necessarily the same direction.

Accordingly, it would have been obvious to one of ordinary skill in the art at the time of the claimed invention to have included in the system of Laska and Corsi et al, the securing mechanism of Berry, Jr. in order to provide a quiet smooth and convenient latch design (column 2, lines 30-34).

Allowable Subject Matter

16. Claims 11-15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

17. The following is a statement of reasons for the indication of allowable subject matter: the instant claims are drawn to test tube rack comprising a base comprising an array of openings and removable, rotatable cover. Wherein, the cover comprises a notch formed as the bottom surface which includes a trunnion travel surface and ledge surface for engaging a base trunnion. The base further comprising a slide surface having a lengthwise groove that mates with one of the lengthwise tongues of an associated slide latch to securely attach the cover to the base.

Additionally, the slide latch having a main body including a top surface with a top projection and an inner side wall having first and second sidewall projections. While many means for attaching a test tube base to a cover exists, none of the prior art teaches or suggest the use of test tube holder base having a groove that mates with the tongue of an associated slide latch, wherein the slide latch has a main body including a top surface having a top projection and an inner side wall having first and second sidewall projections.

Conclusion


18. No claims allowed.


19. The prior art made of record and not relied upon is considered pertinent to applicant's disclose are Kyle *et al*, Kalmakis *et al*, Boje *et al*, Schwartz, Riihimaki *et al*, Williams, Jr., Murofushi *et al*, and Jerge *et al*. They are cited of interest in that they show test tube holder embodiments.

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to P. Kathryn Bex whose telephone number is (703) 306-5697. The examiner can normally be reached on Mondays-Thursdays from 6:00 am to 3:30 pm EST.

The fax number for the organization where this application or proceeding is assigned is (703) 305-7718 for official papers prior to mailing of a Final Office Action. For official papers after mailing of a Final Office Action, use fax number (703) 305-3599. For unofficial or draft papers use fax number (703) 305-7719. Please label all faxes as official or unofficial. The above fax numbers will allow the paper to be forwarded to the examiner in a timely manner.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0661.


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9/20/01


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